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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,380

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Tapani Niemela

P06,0154

2558

26574

7590

11/26/2008

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EXAMINER

PRICE, CRAIG JAMES

ART UNIT

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3753

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DELIVERY MODE

11/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,380	<b>Applicant(s)</b> NIEMELA, TAPANI	
	<b>Examiner</b> Craig Price	<b>Art Unit</b> 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/12/2008 has been entered.

### ***Drawings***

2. Applicant's amendment overcomes the drawing objections.

### ***Specification***

3. The amendment filed 11/12/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The limitation "non-sealed" does not appear to have written support in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1,2,5-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "non-sealed" does not appear to have written support in the specification. Appropriate correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "mating with said recess in a non-sealed abutment" is unclear. It appears in the Figures shown that the flat face of the valve 6, seals against o-ring 7, when protruding part mates with the recess, Therefore it is unclear as to how a "non-sealed condition occurs when mating.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2 and 5-7 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Miyazaki et al. (3,994,317) in view of Tobiasz (5,746,248).

Regarding claim 1, Miyazaki et al. disclose a coupling system "for transfer of an anaesthetic liquid from a bottle to a vaporizer upon insertion of said bottle into said vaporizer". Regarding "for transfer of an anaesthetic liquid from a bottle to a vaporizer ", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The coupling system comprising a bottle part (16,35) comprising a first valve with a first spring-loaded valve body (20) and a first reactive body (35), and a "vaporizer" part (50) comprising a second valve with a second spring-loaded valve body (66) and a second reactive body (60), the bottle part and the vaporizer part being connected to each other, "after insertion of the bottle into the vaporizer", with the first reactive body disposed relative to the first spring loaded valve body to act on the second spring-loaded valve body in an opening direction, and the second reactive body to act on the first spring-loaded valve body in an opening direction, to provide a flow-path for the "anaesthetic" liquid. A seal (21) disposed between the first valve body and the first reactive body of the bottle part, and a further seal (on the end of 66 between 66 and 62 best shown in figure 2B) disposed between the second valve body and the second reactive body of the "vaporizer" part, the seal and the further seal being positioned, and the first and second reactive bodies being disposed relative to the seal and the further seal to cause, when the bottle part and the

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vaporizer part are coupled together, the seal of the bottle part to abut sealingly against the second reactive body, and the further seal of the vaporizer part to abut sealingly against the first reactive body as shown in figure 2 and 3.

Regarding claim 2, Miyazaki et al. disclose that the distance between the seal and the further seal and the respective first and second reactive bodies have a distance therebetween that causes, when the bottle part and the vaporizer part are coupled together, the seal of the vaporizer part to first come into contact with the first reactive body, as shown in figure 2A (Col. 4, Lns. 21-34).

Miyazaki et al. are silent to having the first valve body having a recess therein and the reactive body having a protruding part having a shape conforming to the recess.

Tobiasz discloses a coupling which teaches a first valve body having a recess (30) therein and the reactive body having a protruding part (the part of 5 meeting with 30) having a shape conforming to the recess.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a recess therein in the first body and the reactive body having a protruding part having a shape conforming to the recess, as taught by Tobiasz in order to guide the spring loaded valve to the home seating position during disconnection and align the two halves during connection.

Regarding method claims 5 -7, the device shown by Miyazaki et al. and Tobiasz will perform the methods as recited in claims 5 -7, during normal operational use of the device, the method of making or using the device is inherent in using the apparatus.

***Response to Arguments***

7. Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive. Applicant's argument that Miyazaki et al. does not disclose a seal located between the valve body and the reactive body of the female assembly is not persuasive, since the "V shaped seal" shown best in Figure 3 near the starting point of leader line 37, is clearly cross-hatched as a material made from rubber. Furthermore, in viewing Figure 1 or 2B, it can be seen that this "V shaped "seal must be a seal because this seal is one of the two seals that seal the unit when this half is in the disconnected position, the other seal being 64. The fact that the inventor does not describe the intended usefulness of this "v shaped " seal is not reason enough that one of ordinary skill in the art could not anticipate that this is a seal, when this must be a seal in order for the unit to remain leak-tight in the disconnected state. Applicant's argument concerning that the combination of references destroys the Miyazaki et al reference is not persuasive as the recess of Tobiasz would only provide a recess within the packing layer/seal 121 of Miyazaki et al. thereby maintaining the integrity of the seal.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig Price whose telephone number is (571)272-2712. The examiner can normally be reached on 7AM - 5:30PM Mon-Thurs, Increased flex time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CP  
/C. P./  
Examiner, Art Unit 3753

23 November 2008

/John Rivell/  
Primary Examiner, Art Unit 3753